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AF/2643

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket Number (Optional)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as ~~first class mail~~ *Express Mail* in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on _March 8, 2005_

Signature _Lee Weinstein_

Typed or printed name _Lee Weinstein_
Express Mail # ED065355541US

In re Application of
Lee Weinstein + Scott Brown

Application Number	Filed
09/752,365	12/29/2000

For _Method and Apparatus Facilitating the Placing, Receiving, and Billing of Telephone Calls_

Art Unit	Examiner
2643	Barry W. Taylor

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) $_____

☑ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: $ _250_

☑ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☐ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____ . I have enclosed a duplicate copy of this sheet.

☑ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

☑ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Lee Weinstein
Signature

Lee Weinstein
Typed or printed name

_(781) 861-9229_
Telephone number

_3/8/05_
Date.

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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Lee Weinstein
12 Village Circle
Lexington, MA 02420
E-mail: LeeWeinstein@comcast.net
Phone: (781)861-9229
Fax: (781)861-9449

March 8, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Office action dated 9/8/04 regarding U.S. patent application number 09/752,365

Dear Sirs:

In response to the office action dated 9/8/2004 (copy attached) regarding U.S. patent application number 09/752,365, the inventors request reconsideration of the examiner's final rejection of the claims, and here present arguments and amendments which are believed to render the claims allowable. The $510 fee for the required three-month extension of time is attached. The inventors also hereby provide a notice of appeal, and the required $250 fee, attached hereto.

In item 1, the examiner rejects claim 1 under 35 U.S.C 112, first paragraph, as failing to comply with the written description requirement, stating that a text search was unable to find the terms "allowed callers from who customers are willing to receive calls" in the specification. One of the main innovative points of the present invention is that calls can only be received from allowed callers, and that until a call recipient allows a caller, no calls can be received from that caller. Call-enabling table 834 in central customer database 816 in figure 8 contains the allowed-caller data. The first paragraph on page 61 describes a user setting up "allowed call reception times". The brief description of figure 6 speaks of "times and dates of allowed call reception from a selected caller". The last paragraph on page 15 speaks of "The allowed contact times for John to call Mary". The last paragraph on page 16 speaks of the user filling in "allowed contact time windows". Since an allowed contact time window must be filled in for each caller, it would be clear to one of ordinary skill in the art that each caller specified is inherently an allowed caller and each caller not specified is inherently not an allowed caller. The last paragraph of page 29 refers to callers being able to access "names of people he is presently allowed to contact". A caller who is allowed to contact a given person is inherently an allowed caller for that given person. This would be clear to one of ordinary skill in the art. We submit that all the above-referenced parts of the specification (and many more) give adequate support to claim 1 as amended as required by 35 U.S.C. 112, first paragraph.

In item 2, the examiner rejects claim 15 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, stating that a text search was unable to find the terms "timing telephone connection time". Real-time clock 836 in figure 8 provides support in the figures. The last paragraph on page 36 speaks of how "timing

software actuates SS7 interface 823 to 'tear down' or disconnect any call in progress when the account balance hits zero". It is inherent in this feature of the invention that call connection times are being monitored. We thus submit that this would be clear to one of ordinary skill in the art, and that claim 15 as amended has adequate 35 U.S.C. 112 first paragraph support in the specification.

In item 3, the examiner rejects claim 51 under 35 U.S.C 112, first paragraph, as failing to comply with the written description requirement, stating that a text search was unable to find the terms "specifying a call-initiating party", "specifying a call-receiving party", "verifying a call time is within", and "checking with a database to verify that said call-initiating party is specified as an allowed caller by said call-receiving party", and "allowed caller". The method described in claim 51 in inherent in the examples given in the brief description, detailed description, and in the figures. An example of "specifying a call-initiating party" is shown in part in enabled caller list 504 and "add new contact" button 501 in figure 5, and in part in the call management screen shown in figure 6. The step of verifying that a call time is within an allowed call time window is referred to in the specification as setting up "allowed call times" in the last paragraph of page 16. How the system uses allowed call times is also referred to in the next to the last paragraph of page 17 and the first paragraph of page 18. The exact mechanics of specifying allowed call reception times are depicted in the bottom half of the configuration screen depicted in figure 6. We submit that it would be clear to one of ordinary skill in the art how to implement the method of claim 51, given the specification and the drawings, and we submit that to one of ordinary skill in the art having read the patent application in its entirety, the method of claim 51 would be an inherent part of the examples given in the specification.

In item 4, the examiner rejects claim 76 under 35 U.S.C 112, first paragraph, as failing to comply with the enablement requirement. We note here that we incorrectly referred to this claim as claim 75 in our response to the last office action. We also note here that we should have numbered this claim 77, as noted below by the examiner, since there was a claim 76 in the original patent application, which we cancelled after the first office action. We apologize for these errors and will hence forth refer to the claim at issue as claim 77, as requested by the examiner. Claim 77 was copied from U.S. patent #6,519,570 (issued to Faber) to evoke an interference. It appears that we are unclear on the exact mechanics of properly evoking an interference. We feel that U.S. patent #6,519,570, which describes a method for auctioning professional services provider's time over the internet is rendered obvious by the present invention (in specific the section of the specification beginning on page 42, entitled "Time Auction Features"). We contend that in the present invention, all the "logic units" described in claim 77 are inherent in the hardware of our figure 8, as is the controller computer and communications interface. Though the referenced patent partitioned its hardware functionality differently, it accomplishes the same function as the present invention, using substantially similar hardware. We submit that the invention described in the issued patent is obvious in light of, if not identical to the time-auction aspect of the present invention, and we request that an interference be invoked. The provisional application on which the present application is based is substantially identical to the present application, and predates the Faber application, though it does not predate the application listed as a related prior application in the Faber application (though our date of invention may predate that related application). The

question of whether the Faber application anticipates an aspect of the present application or vice versa depends on what is covered in the related prior Faber application. We request the examiner investigate this.

In item 5, the examiner objects to claim 15 as depending on previously cancelled claim 5. In the attached amendment we correct this error by making this claim dependent on claim 1, and including the limitation previously contained in cancelled claim 5.

The examiner objects to the accidental lack of a carriage return between claims 67 and 68. This error has been corrected. The examiner states that it was not clear whether claims 67 and 68 were meant to be combined. We submit that it was clear that they were not meant to be combined, since the required period at the end of claim 67 was present, and the required number at the beginning of claim 68 was present.

The examiner objects to the accidental lack of a carriage return between claims 71 and 72. This error has been corrected. The examiner states that this made it unclear whether the two claims were intended to be combined. This should not have been unclear, since the required period at the end of claim 71 was present, and the required number at the beginning of claim 72 was present. This should additionally not have been unclear, since we specifically called the examiner's attention to claim 71 in our response to the previous office action.

The examiner notes that claim 76 was previously canceled, and the claim added in the last amendment as claim 76 should be numbered 77. This has been corrected.

In item 6 the examiner rejects claim 76 under U.S.C. 102(e) as being anticipated by Faber et al in U.S. patent #6,519,570. We cannot concur with the examiner on this, since the provisional application on which this application is based (and which included substantially the entire specification of this application) predates the Faber application. The question, as noted above, is whether the prior related application listed in the Faber application includes material which anticipates the time-auction aspect of the present invention. This has not been indicated by the examiner, and is critical. We request that the examiner respond to this issue.

In item 7, the examiner rejects claims 1, 7, 9-11, 13, 15, 22-23, 25, 27, 29-38, 40-44, 48, 51, 53-54, 59-61, 63, 66-68, and 71-75 under 35 U.S.C. 103(a) as being unpatentable over Glen (5,907,677) in view of DuVal (5,818,836) and Haste (6,665,389) further in view of Cho (5,937,039). We do not believe there is anything in the above references that suggest they all be combined. In addition, the Cho patent requires users to record and store the voice messages describing their absence (and perhaps suggesting alternate call times). It is not a system for enforcement of unreachability during prescribed times, and it is certainly not a system allowing specification of reachability within certain times. It does not automatically generate messages. It requires users to record messages. This is very far from the features of the present invention the examiner claims that combining Cho with the other references listed will make obvious. We have previously objected to the combining of what is now a sub-combination of the examiner's suggested combined references, as containing nothing to suggest their combination. The examiner has stated that previous arguments are moot in view of new grounds of rejection, but since the new

ground of rejection relies in this case on the old, we submit that our previous argument in this regard is not mute.

In item 8 the examiner rejects claims 8, 46-47, and 49-50 under U.S.C 103(a)as being unpatentable over Glenn (5,907,677) in view of DuVal (5,818,836), Haste (6,665,389) and Cho (5,937,039) further in view of Lauffer (6,549,889). Again, we submit that there is nothing in the above references suggesting that they all be combined.

Although the applicants have pointed out to the examiner in the response to the previous office action that claim 71 has not been addressed by the examiner, and that claim 71 is an independent claim unique and apart from all other claims in that it claims an aspect of the present invention which facilitates the placement of long-distance telephone calls at optimized rates, the examiner has continued to lump the rejection of claim 71 with other claims covering substantially different aspects of the present invention. None of the references cited by the examiner to date have addressed the patentability of claim 71.
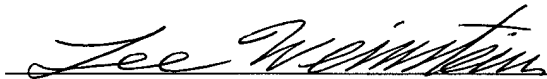
Claim 67 is also an independent claim which has not been properly addressed by the examiner. Claim 67 claims an aspect of the present invention facilitating the placing of international telephone calls for vastly reduced rates. None of the references the examiner has cited appear to be prior art to this claim.

A full set of amended claims (indicating the status of each claim parenthetically as required) is attached hereto.

In summary, given the attached amendments to the claims, we request reconsideration and allowance of all claims by the examiner.
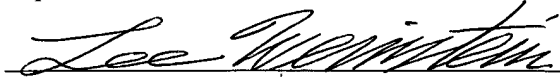
We invite the examiner to contact Lee Weinstein by telephone at (781)861-9229 to discuss any issues which might be more expediently resolved if they were discussed over the phone.

Sincerely

Lee Weinstein

Certificate of express mailing: I certify that this document including the attached amended claims, check for $760, and copy of the related office action were deposited with the US Postal Service as Express Mail, post office to addressee, March 8, 2005, express mail label number ED065355541US.

Lee Weinstein

Claims 2-6, 12, 14, 16-21, 24, 26, 28, 39, 45, 52, 55-58, 62, 64-65, 69-70, 76 are cancelled.

APPARATUS CLAIMS:

1.   (Previously presented) An apparatus facilitating the placing conferenced multiple outbound telephone calls, comprising:

            a.   an internet-connected computer for receiving dialing information over the internet;

            b.   an outbound call engine capable for placing a plurality of outbound telephone calls, said call engine responsive to said dialing information;

            c.   call conferencing means capable of connecting a plurality of outbound telephone calls together;

            d.   a database comprising "allowed times" when customers have specified they are willing to receive calls, and "allowed callers" from whom customers are willing to receive calls;

            e.   means for automatically communicating said allowed times to callers who attempt to initiate calls outside said allowed times; and

            f.   enabling means for enabling said outbound call engine only when said allowed time and allowed caller criteria are met.

7.   (Previously presented) The apparatus of claim 1, wherein said allowed time criteria is separately definable for different allowed callers.

8.   (Previously presented) The apparatus of claim 7, wherein said enabled caller information further comprises for each customer allowed contact time windows during which

calls will be accepted from other customers, further
comprising means to automatically notify a customer by e-
mail when an enabled caller's last allowed contact time
windows have expired.

9.   (Previously presented) The apparatus of claim 1,
wherein customers from whom calls will be accepted can be
defined as a group.

10.   (Original) The apparatus of claim 9, wherein said
dialing information for a customer calling as a member of a
group includes both group-identifying information and
individual-customer-identifying information.

11.   (Original) The apparatus of claim 10, wherein said
call-acceptance criteria further comprises call-blocking
information specifying for each customer any individual
customers from whom calls will not be accepted.

13.   (Original) The apparatus of claim 7, further
comprising call-acceptance criteria specifying which
customers can call a given customer and which criteria are
modifiable via a website by said given customer.

15.   (Currently amended) The apparatus of claim 1̲5̶,
        further comprising:
a database for storing customer information;
        means for timing telephone connection time;
        means for calculating charges based on telephone
connection time; and
        wherein said database further comprises past charges
accrued for each customer and billability status for
customers, indicating whether each customer is billable for
calls they set up, and whether they are billable for calls
others set up to them, wherein billability status for each
customer with respect to each other customer may be
individually defined.

22. (Original) The apparatus of claim 7, wherein said database further comprises call scheduling information, and conferenced outbound telephone calls may be scheduled in advance and placed at pre-determined times, and call schedule data for a given customer may be accessed and modified by that customer via a website.

23. (Previously presented) The apparatus of claim 7, further comprising means for playing to a call recipient at the beginning of a call an audio announcement identifying the other party to said call, and means for including in said audio announcement information about the last time said other party placed a conferenced outbound call between himself and said recipient.

25. (Original) The apparatus of claim 7, further comprising means for playing to a call recipient at the beginning of a call an audio greeting in said call recipient's own voice.

27. (Original) The apparatus of claim 11, further comprising automatic means for sending an e-mail notification to a customer if someone said customer has designated as blocked tries to set up a call to said customer.

29. (Original) The apparatus of claim 1, further comprising a web-based dialing directory with clickable representations of numbers to be dialed.

30. (Previously presented) The apparatus of claim 7, further comprising means for encrypting membership numbers of other members as seen by a given member, based on the given member's own member number, and wherein customers are identified to each other through said database by uniquely encrypted member numbers.

31.   (Previously presented) The apparatus of claim 1, further comprising privacy-protected mail means for leaving a private message for an intended call recipient if an intended recipient is not reachable, said voice mail being retrievable only by the intended recipient through the use of private member-identification information.

32.   (Original) The apparatus of claim 31, further comprising inbound call receiving means allowing retrieval of privacy-protected voice mail by dialing a number and entering member identification information.

33.   (Original) The apparatus of claim 7, further comprising means allowing any member to automatically generate a temporary membership number for a prospective member, and means to automatically generate a permanent membership for that prospective member when that prospective member uses said temporary membership number to become a member, and automatically replace occurrences of said temporary membership number in said database with member numbers uniquely related to said permanent member number.

34.   (Original) The apparatus of claim 1, further comprising means for serving a web page indicative of call placement progress.

35.   (Original) The apparatus of claim 34, further comprising means to serve a web page allowing call placement options of an intended call does not go through.

36.   (Original) The apparatus of claim 35, further comprising means for periodically checking a busy line, and setting up a call when said line stops being busy.

37.   (Original) The apparatus of claim 36, further comprising timing means to stop the checking of the busy line after a customer-specified amount of time.

38.   (Previously presented) The apparatus of claim 7, wherein said database further comprises for each customer phone numbers at which said customer can be contacted, and further comprising web-based sign-up and account access means, and automated outbound call placement during sign-up, wherein said outbound calls are placed to all contact numbers specified for the person signing up, and proper PIN code entry is required.during said automated calls during sign-up in order to validate phone numbers to be called to reach said person.

40.   (Original) The apparatus of claim 7, wherein said database further comprises information for each customer indicating at what phone numbers said customer can be dialed.

41.   (Original) The apparatus of claim 40, wherein said database further comprises for each customer said customer's preferences as to what phone said customer is allowed to be called at and at what times.

42.   (Previously presented) The apparatus of claim 7, wherein said database further comprises for each customer what phone numbers said customer is reachable at by any particular other customer.

43.   (Original) The apparatus of claim 7, wherein said database further comprises for each customer past call information including time of each call and member number of calling or called party, and further comprising means for serving up such past call information as web page data.

44.   (Original) The apparatus of claim 43, further comprising means for disabling or enabling callers in response to web click data received from a browser viewing said past call information.

46. (Previously presented) The apparatus of claim 1, wherein said database further comprises for each customer professional services rate information, and further comprising means to charge customers for professional service time of a called party in addition to connection charges.

47. (Original) The apparatus of claim 46, further comprising means for serving up web-based schedule information for professional service providers, allowing web-based sign-up for paid telephone time with professional service providers.

48. (Original) The apparatus of claim 23, further comprising means for a called party to initiate automatic delivery of a pre-recorded audio message to a caller prior to and in place of connecting said caller to said called party.

METHOD CLAIMS

49. (Original) A method of doing business comprising auctioning professional service time on the web.

50. (Original) A method of fund-raising comprising auctioning teleconference time with celebrities on the web, automatically calling high bidders and connecting them to said teleconference, and automatically billing teleconference participants the amounts they bid to be on said teleconference.

51. (Previously presented) A method for placing conferenced multiple outbound telephone calls, comprising:

a.   Receiving dialing information specifying a
call-initiating party, a call-receiving party, and
a call time over the internet;

b.   checking within a database to verify that
said call time is within allowed contact time
window criteria set up by said call-receiving
party regarding a call-initiating party;

c.   checking within a database to verify that
said call-initiating party is specified as an
allowed caller by said call-receiving party;

d.   placing a plurality of outbound telephone
calls in response to said dialing information only
if said call time falls within said allowed
contact time window criteria and said call-
initiating party is listed as an allowed caller by
said call receiving party;

e.   connecting said multiple outbound calls
together as a conference call in response to both
called parties answering said calls.

53.   (Previously presented) The method of claim 51
wherein said conferencing connection is done external to a
telephone company switch.

54.   (Previously presented) The method of claim 51
wherein the connecting of said outbound calls further
comprises sending digital network commands to a telephone
carrier switch to offload and maintain the connection.

59.   (Previously presented) The method of claim 51,
further comprising checking allowed group contact criteria
if said dialing information indicates that said call-
initiating party is initiating said call as a member of a

call-enabled group, and placing said call only if said group is currently contact-enabled by said call-receiving party.

60.   (Original) The method of claim 59, wherein said calling information is indicative of both individual information and group information.

61.   (Previously presented) The method of claim 60, wherein said group must be currently enabled and said individual must not be currently disabled for said call-receiving party within said database in order for said conferenced calls to be placed.

63.   (Original) The method of claim 51, further comprising serving up customer information as a web page, and accepting customer modification of customer call setup and call-receiving parameters via the internet.

66.   (Previously presented) The method of claim 51, wherein said database further comprises billability status, and where billability status may include fully billable status, split-billing status, or non-billable status, and wherein the billability status of each customer may be individually defined with respect to every other customer..

67.   (Previously presented) A method of placing an international telephone call between a calling party and a called party, comprising initiating outbound telephone calls to said called party and said calling party through an internet-based interface, and connecting said outbound calls together after both said parties answer said outbound calls.

68.   (Previously presented) The method of claim 67, wherein said calling party is in a first country, and said called party is in a second country, and said outbound telephone calls originate from a third country.

71. (Previously presented) A method for placing long-distance telephone calls at optimized rates, comprising supplying a calling party's number and a called party's number through a website, selecting a telecommunications provider to connect said called party and said calling party based on rate information, placing outbound calls to said called party and said calling party, and connecting said called party to said calling party after both said parties answer said outbound calls.

72. (Previously presented) The method of claim 51, further comprising automatically making conferenced outbound calls at times scheduled in advance in said database.

73. (Previously presented) The method of claim 51, further comprising automatically playing to said call-receiving party at the beginning of a call an audio announcement identifying the other party to said call, and allowing said call recipient to deliver an audio message to said calling party without being connected to said calling party.

74. (Original) The method of claim 73, further comprising automatically playing to said call-receiving party at the beginning of a call audio information about the time the call-initiating party last called.

75. (Previously presented) The method of claim 51, further comprising playing to the call-receiving party at the beginning of a call an audio greeting in the call-receiving party's own voice.

77. (Previously presented) A system for establishing a real-time communications connection between a user and a selected information service provider for a live, real-time conversation, the system comprising:

a communications interface; and

a controller computer linked with the communications interface, the controller computer having:

a first logic unit to provide a list of information service providers from a wide array of fields of service to the user;

a second logic unit, in response to the user selecting the selected information service provider from the list, to assign the user a position in a queue when one or more other users have also selected the selected information service provider, the queue having a plurality of other positions, each occupied by one of the one or more of other users waiting to communicate with the selected information provider;

a third logic unit to receive a bid from the user when the user desires to advance position within the queue;

a fourth logic unit to compare the bid with each price being offered by each of the one or more other users, such that each price being offered by each of the one or more other users is initially equal to a price charged by the selected information service provider for providing services in a live, real-time conversation with the user;

a fifth logic unit to advance the user to a position in the queue ahead of each other positions occupied by each other users whose price is lower than the bid; and

a sixth logic unit to establish a real-time communications connection via the communications interface between the user and the selected information service provider for the live real time conversation when the user advances to a first

position in the queue and the selected information service
provider is available to communicate with the user.

Click Call

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,365	12/29/2000	Lee Weinstein		8453

			EXAMINER
28731	7590	09/08/2004	TAYLOR, BARRY W

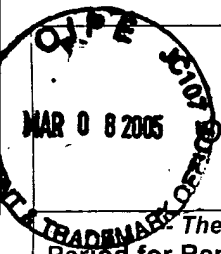LEE WEINSTEIN
35 FAIRMONT ST #3
ARLINGTON, MA   02474

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/752,365	WEINSTEIN ET AL.
Office Action Summary	Examiner	Art Unit
	Barry W Taylor	2643

MAR 0 8 2005

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>See Continuation Sheet</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,7-11,13,15,22,23,25,27,29-38,40-44,46-51,53,54,59-61,63,66-68 and 71-76</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   **Office Action Summary**   Part of Paper No./Mail Date 20040901

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1.   Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "allowed callers from whom customers are willing to receive calls".

2.   Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "timing telephone connection time".

3.   Claim 51 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "specifying a call-initiating party". The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "specifying a call-receiving party". The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "verify that call time is within". The Examiner has preformed a text search of Applicant's specification and cannot find support for the newly added terms of "checking with a database to verify that said call-initiating party is specified as an allowed caller by said call-receiving party". The Examiner performed text search of "allowed caller" and no results were found.

4.   Claim 76 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner is unable to determine from the originally filed specification as to how one of ordinary skill in the art would be able to make and use the invention. The

specification provides no basis for the claimed subject matter. Specifically, as by way of example, claim 76 generally recites providing list of service providers for user selection. The system then places user in queue. Next, a bid is received and compared with other bids and if bid is higher then user placed higher in queue. The Examiner is unable to find any support in Applicant's specification that enables user to select service provider let alone using queue.

Claim Objections

5.   Claim 15 is objected to because of the following informalities: Claim 15 depends upon previously cancelled claim 5. Appropriate correction is required.

Claim 67 is objected to because of the following informalities: It is unclear to the Examiner as to whether Applicant's intend to include claim 68 into currently amended claim 67 or Applicant's forgot to press the carriage return key to separate claim 67 from claim 68. Appropriate correction is required.

Claim 71 is objected to because of the following informalities: It is unclear to the Examiner as to whether Applicant's intend to include claim 72 into currently amended claim 71 or Applicant's forgot to press the carriage return key to separate claim 71 from claim 72. Appropriate correction is required.

Claim 76 is objected to because of the following informalities: Claim 76 was previously cancelled (see paper number 6, Amendment "A", dated 6/27/2003, page63).

It appears newly added claim 76 should read as newly added claim 77. Appropriate

correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claim 76 (should read as claim 77 see 112 rejection listed above) is

rejected under 35 U.S.C. 102(e) as being anticipated by Faber et al (6,519,570

hereinafter Faber). The following rejection is being made for what is best understood by

the Examiner due to numerous 112 rejections listed above.

Regarding claim 76. Faber teaches a system for establishing a real-time

communications connection between a user and a selected information service provider

for a live, real-time conversation, the system comprising (col. 8 lines 40-44):

a communication interface (col. 8 line 45); and

a controller ... (col. 8 line 46-47) having:

a first logic ... (col. 8 lines 48-50);

a second logic ... (col. 8 lines 51-58);

a third logic ... (col. 8 lines 59-60);

a forth logic ... (col. 8 lines 6167);

a fifth logic ... (col. 9 lines 1-4);

a sixth logic ... (col. 9 lines 5-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 7, 9-11, 13, 15, 22-23, 25, 27, 29-38, 40-44, 48, 51, 53-54, 59-61, 63,

66-68 and 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn

et al (5,907,677 hereinafter Glenn) in view of DuVal (5,818,836) and Haste, III

(6,665,389 hereinafter Haste) further in view of Cho (5,937,039).

Regarding claims 1, 22, 25, 29-38, 40-44, 51, 67-68, 71-73 and 75. Glenn

teaches a method for establishing anonymous communication links for Internet users

who are communicating over a Chat server, as well as other on-line services (col. 2 line

65 – col. 3 line 30). Glenn teaches subscribers access Chat page to obtain telephone

number to establish anonymous voice connection without exchanging telephone

numbers (col. 3 lines 62-66).

According to Applicant's, Glenn does not teach the use of the website to initiate

calls (see paper number 6, Amendment "A", dated 6/27/03, page 2 lines 4-7).

DuVal teaches method and apparatus for anonymous voice communication using

an online data service (abstract). DuVal modifies the Chat page (figure 4) to include

window (see pull down window 74 figure 4) or icons (see icons 108 and 86 figure 4) to

be selected by subscribers for anonymous voice call. DuVal discloses although two

parties are shown in figures, it is to be understood that numerous parties may be

connected to the system (col. 5 lines 13-16). DuVal discloses the system may call the

parties or one of the parties may call the system to set up the anonymous voice

communication (col. 9 line 66 – col. 10 line 8, col. 11 lines 9-22). DuVal discloses that

800, 900, or local number may be used for a carrier or non-carrier based service (col.

12 lines 3-13). DuVal discloses the parties must agree, without revealing their identity,

upon a time to call (col. 11 line 55 – col. 12 line 13). DuVal discloses billing functions

including using credit cards and checking account (col. 13 line 62 – col. 14 line 11).

DuVal discloses using greetings which allow the receiving party to accept or reject the

call (col. 16 lines 1-16) as well as offering other party pays option (col. 16 line 16-65).

DuVal discloses that either party can initiate an anonymous voice connection (col. 16

line 65). DuVal discloses parties currently involved with public or private chat can

simply click on icon (see 86 or 108 figure 4) or select menu (see 76 figure 4) for

anonymous voice connection. DuVal discloses the possibility for scheduling an

anonymous voice call (col. 19 lines 11-41). DuVal discloses a distribution

implementation to establish anonymous voice connection for parties located in different

cities (col. 19 line 52 – col. 20 line 40) wherein the closest node is selected to connect

the requesting party to a remote party (col. 20 lines 55-65).

According to Applicant's, Glenn fails to use database comprising times when

customers have specified they are willing to receive calls (see paper number 6,

Amendment "A", dated 6/27/03, page 1, the prior art uncovered by Examiner section).

Haste improves on prior art by allowing subscribers to select a series of times he

or she wants associated to telephone numbers (col. 1 lines 63-65). In other words,

Haste allows for multiple telephone numbers to be listed with specified times of day

during which the subscriber can be reached at those numbers (col. 2 lines 63-67, col. 3

lines 6-34). Haste also allows profile to be set up by users that only allows certain

"callers" meeting user selected profile (see figure 1B "Allow contact from members who

fit my profile only:").

Applicant's further amend and argue that Glen in view of Haste fail to teach

communicating the dialing limitations back to the caller (see paper number 8,

Amendment "B", dated 6/17/2004, page 1 last paragraph).

Cho allows subscribers to choose in advance an absent message representing

his absent reason which is then transmitted to the caller's who are attempting to call the

subscriber (abstract, col. 1 lines 19-22, col. 3 lines 48-51, col. 4 lines 63-65, col. 5 lines

46-51, col. 7 lines 40-47). Cho is very clear in that the present invention has the

advantage that the caller can be advised of the absent reason of the called-up party

and the proper time for calling up again (col. 9 lines 14-17).

Therefore, it would have been obvious for any one of ordinary skill in the art at the time of the invention to modify the on-line Chat page as taught Glenn in view of DuVal and Haste to incorporate absent message as taught by Cho for the benefit of expanding user profiles to incorporate an absent reason and proper time to call thereby enabling the caller to know when to call back and the reason the called party is not taking telephony calls.

Regarding newly amended claim 7. Glenn fails to teach allowed time criteria are separately definable for different allowed callers.

Haste further shows user selectable profiles include: "Hide your profile form this member and disallow further contact:", "Allow Phone Calls from this member:", "Keep my ad hidden from the following email addresses or members:", "Keep my ad hidden from everyone BUT the following email addresses or members:" (see figure 1B).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the on-line Chat page as taught by Glenn in view of Duval to first establish user profiles as taught by Haste for the benefit of establishing and selecting what profiles to be employed during anonymous communication.

Regarding claims 9-11, 27 and 59-61. Glenn teaches defining group (col. 4 lines 6-7).

Regarding claims 13 and 63. According to Applicant's, Glenn does not teach the use of the website to initiate calls (see paper number 6, Amendment "A", dated 6/27/03, page 2 lines 4-7).

DuVal teaches method and apparatus for anonymous voice communication using an online data service (abstract). DuVal modifies the Chat page (figure 4) to include window (see pull down window 74 figure 4) or icons (see icons 108 and 86 figure 4) to be selected by subscribers for anonymous voice call. DuVal discloses although two parties are shown in figures, it is to be understood that numerous parties may be connected to the system (col. 5 lines 13-16). DuVal discloses the system may call the parties or one of the parties may call the system to set up the anonymous voice communication (col. 9 line 66 – col. 10 line 8, col. 11 lines 9-22). DuVal discloses that 800, 900, or local number may be used for a carrier or non-carrier based service (col. 12 lines 3-13). DuVal discloses the parties must agree, without revealing their identity, upon a time to call (col. 11 line 55 – col. 12 line 13). DuVal discloses billing functions including using credit cards and checking account (col. 13 line 62 – col. 14 line 11). DuVal discloses using greetings which allow the receiving party to accept or reject the call (col. 16 lines 1-16) as well as offering other party pays option (col. 16 line 16-65). DuVal discloses that either party can initiate an anonymous voice connection (col. 16 line 65). DuVal discloses parties currently involved with public or private chat can simply click on icon (see 86 or 108 figure 4) or select menu (see 76 figure 4) for anonymous voice connection. DuVal discloses the possibility for scheduling an

anonymous voice call (col. 19 lines 11-41). DuVal discloses a distribution

implementation to establish anonymous voice connection for parties located in different

cities (col. 19 line 52 – col. 20 line 40) wherein the closest node is selected to connect

the requesting party to a remote party (col. 20 lines 55-65).

Haste improves on prior art by allowing subscribers to select a series of times he

or she wants associated to telephone numbers (col. 1 lines 63-65). In other words,

Haste allows for multiple telephone numbers to be listed with specified times of day

during which the subscriber can be reached at those numbers (col. 2 lines 63-67, col. 3

lines 6-34).

Therefore, it would have been obvious for any one of ordinary skill in the

art at the time of the invention to modify the on-line Chat page as taught Glenn in view

of DuVal to store plurality of numbers with specified times as taught by Haste for the

benefit of routing calls to work between the times of 8 a.m. and 6 p.m. and then route

calls to cell phone form 6 p.m. to 7:30 p.m. and use home phone from 7:30 p.m. to

midnight as taught by Haste.

Regarding claims 15 and 66. Glenn teaches billing for anonymous voice

connection by using credit card, Cybercash, or other form (column 4). DuVal also

teaches one party may pay the charges associated with the other party (column 16)

Regarding claims 23, 48, and 74. DuVal shows information relating to last

contact (see figure 5 "COUPLE RECORD", and "MESSAGE RECORD").

Regarding claim 53. DuVal shows conferencing done external to a telephone company (see #14 figures 1-3).

Regarding claim 54. DuVal shows digital signal used (see #68 figures 1-3).

8.   Claims 8, 46-47 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al (5,907,677 hereinafter Glenn) in view of DuVal (5,818,836), Haste, III (6,665,389 hereinafter Haste) and Cho (5,937,039) further in view of Lauffer (6,549,889).

Regarding claim 8. Glenn in view of DuVal, Haste and Cho fail to show using allowed contact time.

Lauffer teaches facilitating and delivery of advice to consumers using a server for rapidly assisting in connecting an expert and consumer for real-time communications (abstract). Lauffer server has ability to respond to a consumer's selection of expert by sending the consumer conveyance through means to contact experts that include but are not limited to telephone, Internet telephony, email, audio, and/or video (column 6). Lauffer using time-to-connect and expert compensation rate, time availability, etc (col. 5 lines 1-2, lines 15-16, lines 40-67, col. 6 lines 56-67). Lauffer even discloses that in another embodiment, a special symbol/notation is displayed next to or as part of an experts symbol if he has been certified by selected companies or organizations wherein the symbol/notation can optionally expire, disappear, or change its characteristics (color, etc) after a certain length of time so that the expert is forced to take tests to

maintain certification (column 7). Lauffer even discloses displaying plurality of experts with varying compensation rates (column 7).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the invention as taught by Glenn in view of DuVal, Haste and Cho to modify web page to include expert advice as taught by Lauffer for the benefit of providing subscribers with a list of experts, the time availability of the expert, and the compensation rate for consumer advice with expert as taught by Lauffer.

Regarding claims 46-47 and 49-50. Glenn in view of DuVal, Haste and Cho fail to show charging for professional service.

DuVal teaches method and apparatus for anonymous voice communication using an online data service (abstract). DuVal modifies the Chat page (figure 4) to include window (see pull down window 74 figure 4) or icons (see icons 108 and 86 figure 4) to be selected by subscribers for anonymous voice call. DuVal discloses although two parties are shown in figures, it is to be understood that numerous parties may be connected to the system (col. 5 lines 13-16). DuVal discloses the system may call the parties or one of the parties may call the system to set up the anonymous voice communication (col. 9 line 66 – col. 10 line 8, col. 11 lines 9-22). DuVal discloses that 800, 900, or local number may be used for a carrier or non-carrier based service (col. 12 lines 3-13). DuVal discloses the parties must agree, without revealing their identity, upon a time to call (col. 11 line 55 – col. 12 line 13). DuVal discloses billing functions including using credit cards and checking account (col. 13 line 62 – col. 14 line 11).

DuVal discloses using greetings which allow the receiving party to accept or reject the call (col. 16 lines 1-16) as well as offering other party pays option (col. 16 line 16-65). DuVal discloses that either party can initiate an anonymous voice connection (col. 16 line 65). DuVal discloses parties currently involved with public or private chat can simply click on icon (see 86 or 108 figure 4) or select menu (see 76 figure 4) for anonymous voice connection. DuVal discloses the possibility for scheduling an anonymous voice call (col. 19 lines 11-41). DuVal discloses a distribution implementation to establish anonymous voice connection for parties located in different cities (col. 19 line 52 – col. 20 line 40) wherein the closest node is selected to connected the requesting party to a remote party (col. 20 lines 55-65).

Haste improves on prior art by allowing subscribers to select a series of times he or she wants associated to telephone numbers (col. 1 lines 63-65). In other words, Haste allows for multiple telephone numbers to be listed with specified times of day during which the subscriber can be reached at those numbers (col. 2 lines 63-67, col. 3 lines 6-34).

Lauffer teaches facilitating and delivery of advice to consumers using a server for rapidly assisting in connecting an expert and consumer for real-time communications (abstract). Lauffer server has ability to respond to a consumer's selection of expert by sending the consumer conveyance through means to contact experts that include but are not limited to telephone, Internet telephony, email, audio, and/or video (column 6). Lauffer using time-to-connect and expert compensation rate, time availability, etc (col. 5 lines 1-2, lines 15-16, lines 40-67, col. 6 lines 56-67). Lauffer even discloses that in

another embodiment, a special symbol/notation is displayed next to or as part of an

experts symbol if he has been certified by selected companies or organizations wherein

the symbol/notation can optionally expire, disappear, or change its characteristics

(color, etc) after a certain length of time so that the expert is forced to take tests to

maintain certification (column 7). Lauffer even discloses displaying plurality of experts

with varying compensation rates (column 7).

It would have been obvious for any one of ordinary skill in the art at the time of

invention to modify the invention as taught by Glenn in view of DuVal, Haste and Cho to

modify web page to include expert advice as taught by Lauffer for the benefit of

providing subscribers with a list of experts, the time availability of the expert, and the

compensation rate for consumer advice with expert as taught by Lauffer.

Response to Arguments

9.　　Applicant's arguments with respect to claims 1, 7-11, 13, 15, 22-23, 25, 27, 29-

38, 40-44, 46-51, 53-54, 59-61, 63, 66-68, 71-75 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

10.　　Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

	Application/Control No.	Applicant(s)/Patent Under Reexamination
	09/752,365	WEINSTEIN ET AL.

Examiner	Art Unit	
Barry W Taylor	2643	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-5,937,039	08-1999	Cho, Seung-Hwan	379/93.17
*	B	US-6,519,570	02-2003	Faber et al.	705/8
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.